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## FACSIMILE TRANSMISSION

CONFIDENTIAL

DATE: September 21, 2005

CLIENT-MATTER NUMBER: 22930-06067

## To:

NAME:	FAX No.:	PHONE No.:
Examiner Elaine Gort US Patent & Trademark Office	571-273-8300	571-272-6781

FROM: Colleen Chien

PHONE: (415) 875-2319

RE: U.S. Patent Application Serial No. 09/863,801

Filed: May 22, 2001

Title: Attaining Product Inventory Grouping for Sales in a Group-Buying  
Environment

Applicants: Van Horn, et al.

NUMBER OF PAGES WITH COVER PAGE: 49

## MESSAGE:

## CAUTION - CONFIDENTIAL

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September 21, 2005

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Examiner Elaine Gort  
Examiner Alex Kalinowski  
U.S. Patent & Trademark Office  
Group Art Unit 3627

Re: U.S. Patent Application Serial No. 09/863,801  
Filed: May 22, 2001  
Title: Attaining Product Inventory Groupings for Sales in a Group-Buying  
Environment  
Applicants: Van Horn, et al.  
Attorney Docket No. 22930-0607

Dear Examiners Gort and Kalinowski :

We are submitting this communication (and attached exhibits) in a good-faith attempt to clarify the record in the above-mentioned case and reach agreement on the appropriate response to Examiner's Office communication of 09/08/2005 ("the Communication").

The Communication states that the "appeal brief claims are defective. Claims 10-11, 13-20, 31-32, and 36 have not been cancelled but are not shown in the Claims Appendix. Applicant attempted to cancel these claims in an amendment filed on 2/6/04 which were not entered. See Advisory Action mailed 02/08/05."

From our review of the record,

- Claims 10-11 were cancelled in Amendment A, filed 2/6/04 (see Exhibit A)
- Claims 13-20 were withdrawn in Amendment A, filed 2/6/04 (see Exhibit A)

This Amendment A was made in response to a non-final office action mailed October 22, 2003 (the first in prosecution). The cancelled and withdrawn status of the claims was apparently confirmed in Examiner's final office action mailed March 16, 2004. (see Exhibit B, at "Office Action Summary", which indicate that claims 13-20 were withdrawn, and that 10-11 were not pending). Examiner did not examine either of these sets of claims.

Examiners Elaine Gort & Alex Kalinowski  
September 21, 2005  
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In sum, contrary to the Communication, claims 10-11 and 13-20 appear to have been properly cancelled/withdrawn in the amendment filed 2/6/04, as confirmed in Examiner's final office action mailed March 16, 2004.

From our review of the record,  
- Claims 31-32 and 36 were cancelled in Amendment B, filed 11/5/04 (see Exhibit C)

Examiner confirmed the cancelled status of the claims in the Advisory Action sent on 2/8/05 (see Exhibit D). This action indicated that claims 31-32 and 36 were neither allowed, objected to, rejected, or withdrawn from consideration. Thus, by implication, these claims were cancelled. Furthermore, the Advisory Action indicated that the proposed amendment(s) would "not be entered because they raise new issues that would require further consideration and/or search." This rationale is inapposite to the cancellation of claims.

In sum, contrary to the Communication, claims 31-32 and 36 appear to have been properly cancelled in the amendment filed 11/5/04, as confirmed in the Advisory Action sent on 2/8/05.

Furthermore, as per Section 1.192 of the MPEP, the claims to be presented in the Appeal Brief include only "(9) An appendix containing a copy of the claims involved in the appeal." The cancelled and withdrawn claims at issue above are not involved in the appeal, so we are unclear on what Examiner would like us to do at this point. In addition, Appellants have paid the maximum amount of fees involved in making an appeal and so are thus unsure what corrective action or payment of fees at this point would allow this appeal to be heard.

Please review the information we are providing and contact us to proceed at the information below. We would greatly appreciate your prompt attention to this matter as I will be leaving imminently for maternity leave.

Very truly yours,

FENWICK & WEST LLP



Colleen Chien  
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CVC/kmj  
Enclosures: Exhibits A-D

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